

## **REMARKS**

In response to the office action dated 23 November 2005, the applicants request reconsideration of the above-identified application in view of the following remarks. Claims 1-29 are pending in the application, and are rejected. None of the claims are amended herein.

### **Rejections of Claims Under §102**

Claims 1, 2, 14-16, and 21-22 were rejected under 35 USC § 102(e) as being anticipated by Waites et al. (U.S. 6,788,769, Waites). The applicants respectfully traverse.

Waites issued on September 7, 2004, which is after the 24 August 2001 filing date of the present application. The applicants do not admit that Waites is prior art, and reserve the right to swear behind Waites at a later date.

Independent claim 1 recites a method comprising, among other features, “converting input speech to text and transmitting an instant message comprising the text.”

Independent claim 14 recites an instant-messaging system, comprising, among other features, a controller “to send an instant message to the instant-messaging server.”

Independent claim 21 recites a signal-bearing medium comprising instructions, wherein the instructions when read and executed by a processor comprise, among other features, “transmitting an instant message to an instant-messaging server.”

Waites relates to an internet directory system and method using telephone number based addressing.<sup>1</sup> The “directory system utilizes a user’s telephone number for the respective user’s e-mail address and web home page.”<sup>2</sup> However, Waites does not show or describe transmitting an instant message or sending an instant message as claimed. In fact, the examples of communication in Waites are limited to sending a user e-mail, accessing a user’s web site,<sup>3</sup> a non-computer user calling from a telephone,<sup>4</sup> and sending a fax.<sup>5</sup> Waites also indicates that the

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<sup>1</sup> Waites, Title.

<sup>2</sup> Waites, column 6, lines 22-25.

<sup>3</sup> Waites, column 7, lines 57-65.

<sup>4</sup> Waites, column 8, lines 37-59.

<sup>5</sup> Waites, column 13, lines 17-31.

directory system provides unified messaging enabling users to transmit communications using e-mail, telephone, paging, or fax.<sup>6</sup> Instant messaging is not included in this list.

Instant messaging is substantially different from these other forms of communication. The article Instant Messaging 101 from About.com submitted with the IDS filed on 13 March 2002 indicates that instant messaging is a method of communication that has achieved its own status in the art separate from other forms of communication such as a page:

“Instant Messaging is not only one of the vital part of Internet Conferencing, but is also the seasonable craze in the browser wars at this present time. Instant messaging allows two people to communicate in ‘*real time*’ over the internet, superceding the pace of email. Instant Messaging software allows you to track when another person logs on and logs off of the internet.”<sup>7</sup>

Ogle et al. (U.S. 6,430,604, Ogle), a reference applied in the office action, also discusses instant messaging:

“Instant messaging systems provide for instant, real-time communication between users who are connected to the system through an on-line or electronic networking environment....Such systems are becoming quite popular among users of networks such as the Internet, World Wide Web (hereinafter, “Web”), and internal intranets because they are easy to use and provide a simple way for one user to send a message to another user.”<sup>8</sup>

Waites refers to the directory system as offering the capability to locate the person’s instant message address using a person’s telephone number.<sup>9</sup> Waites also says that the directory system “provides addressing for unified messaging” including instant messaging.<sup>10</sup> Waites does not show or describe transmitting an instant message or sending an instant message as claimed in independent claims 1, 14, and 21. The office action cited the “Field of the Invention” in Waites that mentions instant messaging along with other forms of communication.<sup>11</sup> The “Field of the Invention” does not describe an instant messaging system, but is a broad reference to the field of electronic communications.

<sup>6</sup> Waites, column 11, lines 24-43.

<sup>7</sup> Instant Messaging 101, page 1.

<sup>8</sup> Ogle, column 1, lines 21-33.

<sup>9</sup> Waites, column 8, lines 29-37.

<sup>10</sup> Waites, column 2, lines 55-62.

<sup>11</sup> Office action, page 3.

The office action states that “per applicant’s specification, and as per applicant’s claim language, a paging system is an instant messaging system.”<sup>12</sup> This is not a correct statement. The specification states that embodiments of the invention “may be implemented using any suitable hardware and/or software, such as ..., two-way alphanumeric pagers,... are examples of other possible configurations of electronic computing devices.”<sup>13</sup> This is a reference to a device only, and does not mean that a page is the same as an instant message. The office action has not shown evidence from the prior art that a page is similar to an instant message.

The office action also states that several features are “inherent” in Waites. For example:

“Waites’ originating device inherently comprises a controller...The terminals inherently comprise software on a signal bearing medium.”<sup>14</sup>

The MPEP states that missing matter must be “necessarily present” in the reference to support a rejection based on inherency:

“To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”<sup>15</sup>

The MPEP further states that the examiner must provide a basis to support a determination that the allegedly inherent characteristic necessarily flows from the teaching of the art:

“In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.”<sup>16</sup>

Multiple Federal Circuit decisions emphasize the need for the PTO to furnish evidence in support of claim rejections. For example, the Federal Circuit addressed citation of “basic knowledge and common sense” in rejections in *In re Zurko*:

“With respect to core factual findings in a determination of patentability, however, the Board [Board of Patent Appeals and Interferences] cannot simply reach conclusions based on its own understanding or experience – or on its assessment of what would be basic knowledge or

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<sup>12</sup> Office action, page 12.

<sup>13</sup> Specification, page 7.

<sup>14</sup> Office action, page 3.

<sup>15</sup> MPEP 2112.

<sup>16</sup> MPEP 2112. Emphasis in original.

common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.”<sup>17</sup>

The office action has not provided a evidence of a basis in fact and/or technical reasoning to reasonably support its contention that the “originating device inherently comprises a controller” or that the “terminals inherently comprise software” as is required by the MPEP and *In re Zurko*.

The applicants respectfully submit that Waites does not show all of the features recited in independent claims 1, 14, and 21, and that claims 1, 14, and 21 are in condition for allowance. Claims 2, 15-16, and 22 are variously dependent on claims 1, 14, and 21, and recite further features with respect to claims 1, 14, and 21. For reasons analogous to those stated above, and the features in the claims, the applicants respectfully submit that Waites does not show all of the features recited in claims 2, 15-16, and 22, and that claims 2, 15-16, and 22 are in condition for allowance.

Claims 6-10 and 12 were rejected under 35 USC §102(e) as being anticipated by Andrews et al. (U.S. 6,522,878, Andrews). The applicants respectfully traverse.

Andrews issued on February 18, 2003, which is after the 24 August 2001 filing date of the present application. The applicants do not admit that Andrews is prior art, and reserve the right to swear behind Andrews at a later date.

Independent claim 6 recites a method comprising, among other features, “receiving an instant message.”

Independent claim 10 recites a computing device comprising “a text-to-speech converter to convert text in a received instant message to speech when a speech option is selected, independent of whether a sender of the instant message performed speech input.”

As stated above, instant messaging is substantially different from these other forms of communication. The article Instant Messaging 101 from About.com submitted with the IDS filed on 13 March 2002 and Ogle indicate that instant messaging is a method of communication that has achieved its own status in the art separate from other forms of communication such as paging.

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<sup>17</sup> *In re Zurko*, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).

Andrews relates to in-band audio signaling<sup>18</sup> and describes cellular telephones enabling alphanumeric pages.<sup>19</sup> An alphanumeric page is not an instant message, and the office action has not shown that an alphanumeric page is the same as an instant message as described in, for example, the article Instant Messaging 101 from About.com and in Ogle. The applicants respectfully submit that Andrews does not show or discuss an instant message as is recited in independent claims 6 and 10.

The applicants respectfully submit that Andrews does not show all of the features recited in independent claims 6 and 10, and that claims 6 and 10 are in condition for allowance. Claims 7-9 and 12 are variously dependent on claims 6 and 10, and recite further features with respect to claims 6 and 10. For reasons analogous to those stated above, and the features in the claims, the applicants respectfully submit that Andrews does not show all of the features recited in claims 7-9 and 12, and that claims 7-9 and 12 are in condition for allowance.

Claims 1, 4-16, and 18-29 were rejected under 35 USC § 102(b) as being anticipated by Parvulescu et al. (U.S. 5,724,410, Parvulescu). The applicants respectfully traverse.

Parvulescu relates to a voice messaging terminal.<sup>20</sup> Parvulescu does not relate to instant messaging, and does not mention instant messages.

Independent claim 1 recites a method including “determining whether a speech option is selected at an origin device” and “when the speech option is selected, converting input speech to text and transmitting an instant message comprising the text.”

Independent claim 6 recites a method including “receiving an instant message at a destination-client device, wherein the instant message comprises text” and “determining whether a speech option at the destination-client device is selected and if true converting the text to speech.”

Independent claim 10 recites a computing device including “a text-to-speech converter to convert text in a received instant message to speech when a speech option is selected, independent of whether a sender of the instant message performed speech input.”

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<sup>18</sup> Andrews, Title.

<sup>19</sup> Andrews, column 4, lines 12-22.

<sup>20</sup> Parvulescu, Abstract.

Independent claim 14 recites an instant-messaging system including “an instant-messaging server; a controller to determine whether a speech option is selected at an origin-client device and to send an instant message to the instant-messaging server; and a speech-to-text converter to convert speech to text when the speech option is selected, wherein the instant message comprises the text.”

Independent claim 19 recites an instant-messaging system including an instant messaging server and an origin-client device that includes “an origin controller to determine whether an origin-speech option is selected at the origin-client device and to send an instant message to the instant-messaging server” and “a speech-to-text converter to convert speech to text when the origin-speech option is selected, wherein the instant message comprises the text.” The system also includes a destination-client device including a destination controller to determine whether a destination-speech option is selected at the destination-client device and to receive the instant message from the instant-messaging server and a text-to-speech converter to convert the text to speech when the destination-speech option is selected.

Independent claim 21 recites a “signal-bearing medium comprising instructions, wherein the instructions when read and executed by a processor” comprise “determining whether a speech option is selected at an origin device” and “when the speech option is selected, converting input speech to text and transmitting an instant message to an instant-messaging server, wherein the instant message comprises the text.”

Independent claim 26 recites a pager including “a text-to-speech converter to convert text in a received instant message to speech when a speech option is selected, independent of whether a sender of the instant message performed speech input.”

Each of the independent claims 1, 6, 10, 14, 19, 21, and 26 recites an instant message. As stated above, instant messaging is substantially different from other forms of communication. The article Instant Messaging 101 from About.com submitted with the IDS filed on 13 March 2002 and Ogle indicate that instant messaging is a method of communication that has achieved its own status in the art separate from other forms of communication such as the page or email. One skilled in the art would not construe an email or a page in a reference to also mean an instant message as claimed. The applicant respectfully submits that Parvulescu does not show or describe instant messages, or a system

for supporting instant messages. The office action has not presented evidence showing that the claimed instant message is the same as a page or an email according to one skilled in the art.

In addition, Parvulescu shows a “two-way voice messaging terminal for communicating with a receiving terminal which may or may not be capable of reproducing a voice message transmitted from the voice messaging terminal.”<sup>21</sup> The receiving terminal selection unit 36 of the voice messaging terminal 20 “determines whether the selected receiving terminal is capable of reproducing voice messages” after which “the coded digital signal representing the voice message will be provided to a speech-to-text converter 40, or directly to a protocol encoder 48, accordingly.”<sup>22</sup> In Parvulescu, the voice message will be sent to the speech-to-text converter depending solely on whether the receiving terminal is capable of reproducing the voice message. Parvulescu does not show the claimed speech option that may be selected either in an origin device or a destination-client device. Parvulescu does not show a “speech option” that can be selected in either device.

Finally, the office action states that features found in claims 14, 16, 19, and 21-27 are “inherently” in Parvulescu. The office action has not provided evidence of a basis in fact and/or technical reasoning to reasonably support its contentions that the “[t]he device may be used with a paging system that inherently comprises an instant message server” or that the “sending and receiving terminals each inherently comprise controllers” or that the “sending/receiving terminals inherently comprise software”<sup>23</sup> as is required by the MPEP and *In re Zurko*.

The applicants respectfully submit that Parvulescu does not show all of the features recited in independent claims 1, 6, 10, 14, 19, 21, and 26, and that claims 1, 6, 10, 14, 19, 21, and 26 are in condition for allowance. Claims 4, 5, 7-9, 11-13, 15, 16, 18, 20, 22-25, and 27-29 are variously dependent on claims 1, 6, 10, 14, 19, 21, and 26, and recite further features with respect to claims 1, 6, 10, 14, 19, 21, and 26. For reasons analogous to those stated above, and the features in the claims, the applicants respectfully submit that Parvulescu does not show all of the features recited in claims 4, 5, 7-9, 11-13, 15, 16, 18, 20, 22-25, and 27-29, and that claims 4, 5, 7-9, 11-13, 15, 16, 18, 20, 22-25, and 27-29 are in condition for allowance.

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<sup>21</sup> Parvulescu, Abstract.

<sup>22</sup> Parvulescu, column 4, line 41 to column 5, line 43.

<sup>23</sup> Office action, page 9.

Rejections of Claims Under §103

Claims 3-5, 18, and 23-25 were rejected under 35 USC § 103(a) as being unpatentable over Waites in view of Andrews. The applicants respectfully traverse.

Claims 3-5, 18, and 23-25 are variously dependent on claims 1, 14, and 21, and recite further features with respect to claims 1, 14, and 21.

As discussed above, Waites does not show or describe transmitting an instant message or sending an instant message as claimed in independent claims 1, 14, and 21. Andrews does not supply the features missing in Waites as Andrews does not show or discuss an instant message. Therefore, even as combined, Waites and Andrews do not show all of the features recited in claims 3-5, 18, and 23-25. Furthermore, there is no suggestion for combining Waites with Andrews.

The Office Action states that:

“It would have been obvious...that the receiving pager of Waites’ system could comprise a text-to-speech converter for the advantage of providing a user with an additional interface (hearing) to communicate with.”<sup>24</sup>

The MPEP requires a suggestion and a reasonable expectation of success for a rejection under 35 USC § 103:

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.”<sup>25</sup>

The suggestion or motivation to combine references and the reasonable expectation of success must both be found in the prior art.<sup>26</sup>

As stated above, Waites and Andrews do not show all of the features recited in claims 3-5, 18, and 23-25. Also, the Office Action has not identified prior art as being the source of the above-quoted rationale for combining Waites with Andrews as is required by MPEP 2143.

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<sup>24</sup> Office action, page 5.

<sup>25</sup> MPEP 2143.

<sup>26</sup> MPEP 2143.

The office action has also not identified a reasonable expectation of success in the prior art as is required by MPEP 2143.

The applicants respectfully submit that a *prima facie* case of obviousness has not been established against claims 3-5, 18, and 23-25, and that claims 3-5, 18, and 23-25 are in condition for allowance.

Claims 19-20 and 26-29 were rejected under 35 USC § 103(a) as being unpatentable over Waites in view of Andrews. The applicants respectfully traverse.

Independent claim 19 recites an instant-messaging system, including, among other features, “an instant messaging server” and an origin controller “to send an instant message to the instant- messaging server.”

Independent claim 26 recites a pager including “a text-to-speech converter to convert text in a received instant message to speech when a speech option is selected, independent of whether a sender of the instant message performed speech input.”

Claims 20 and 27-29 are variously dependent on independent claims 19 and 26.

With reference to the remarks above, Waites does not show or describe sending an instant message or a received instant message as claimed in independent claims 19 and 26, respectively. Andrews does not supply the features missing in Waites as Andrews does not show or discuss an instant message. Therefore, even as combined, Waites and Andrews do not show all of the features recited in claims 19-20 and 26-29. Furthermore, there is no suggestion for combining Waites with Andrews.

The office action states that:

“It would have been obvious...that the receiving pager of Waites’ system could comprise a text-to-speech converter for the advantage of providing a user with an additional interface (hearing) to communicate with.”<sup>27</sup>

The office action has not identified prior art as being the source of the above-quoted rationale for combining Waites with Andrews as is required by MPEP 2143. The office action has also not identified a reasonable expectation of success in the prior art as is required by MPEP 2143.

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<sup>27</sup> Office action, page 6.

The applicants respectfully submit that a *prima facie* case of obviousness has not been established against claims 19-20 and 26-29, and that claims 19-20 and 26-29 are in condition for allowance.

Claim 17 was rejected under 35 USC § 103(a) as being unpatentable over Waites in view of Ogle et al. (U.S. 6,430,604, Ogle). The applicants respectfully traverse.

Ogle issued on 6 August 2002, which is after the filing date of the present application. The applicants do not admit that Ogle is prior art, and reserve the right to swear behind Ogle at a later date.

Ogle relates to a system “for enabling messaging systems to use alternative message delivery mechanisms” and shows and discusses instant messaging systems.<sup>28</sup>

Claim 17 is dependent on claim 14, and recites further features with respect to claim 14. The office action states that:

“It would have been obvious...that an IM server could drop a message if the receiving device were not connected for the reason that the server not get overloaded with undelivered messages.”<sup>29</sup>

The office action has not identified prior art as being the source of the above-quoted rationale for combining Waites with Ogle as is required by MPEP 2143. The office action has also not identified a reasonable expectation of success in the prior art as is required by MPEP 2143.

The applicants respectfully submit that a *prima facie* case of obviousness has not been established against claim 17, and that claim 17 is in condition for allowance.

Claims 11 and 13 were rejected under 35 USC § 103(a) as being unpatentable over Andrews in view of Waites. The applicants respectfully traverse.

Claims 11 and 13 are dependent on independent claim 10, and recite further features with respect to claim 10. As discussed above with respect to claim 10, Andrews does not show or discuss an instant message as is recited in independent claim 10. With reference to the remarks

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<sup>28</sup> Ogle, Abstract and Figure 4.

<sup>29</sup> Office action, page 7.

above, Waites does not show or describe transmitting an instant message or sending an instant message. The office action has not shown that Waites supplies the features missing in Andrews. Furthermore, there is no suggestion for combining Waites with Andrews.

The office action states that:

"It would have been obvious...that the sending device could comprise a speech-to-text converter for the purpose of providing an additional interface for the sender."<sup>30</sup>

The office action has not identified prior art as being the source of the above-quoted rationale for combining Waites with Andrews as is required by MPEP 2143. The office action has also not identified a reasonable expectation of success in the prior art as is required by MPEP 2143.

The applicants respectfully submit that a *prima facie* case of obviousness has not been established against claims 11 and 13, and that claims 11 and 13 are in condition for allowance.

Claims 2-3 were rejected under 35 USC § 103(a) as being unpatentable over Parvulescu in view of Brunet et al. (U.S. 5,995,590, Brunet). The applicants respectfully traverse.

Claims 2-3 are dependent on claim 1. Claim 2 recites the method of claim 1, further comprising "when speech is not selected at the origin device, receiving input text and transmitting the instant message, wherein the instant message comprises the input text." Claim 3 is dependent on claim 2, and recites further features with respect to claim 2.

As discussed above, Parvulescu does not show or describe instant messages, or a system for supporting instant messages. Brunet does not supply the features missing in Parvulescu as Brunet does not show or discuss an instant message. Therefore, even as combined, Parvulescu and Brunet do not show all of the features recited in claims 2-3. Furthermore, there is no suggestion for combining Parvulescu with Brunet.

The office action states that:

"It would have been obvious...that a direct text input method could be implemented with the terminal of Parvulescu for the purpose of allowing users to carry on conversations unobtrusively."<sup>31</sup>

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<sup>30</sup> Office action, page 7.

<sup>31</sup> Office action, pages 10-11.

The office action has not identified prior art as being the source of this quote from the office action as is required by MPEP 2143. For example, Parvulescu shows a voice messaging terminal in which, on occasion, a voice message is converted to a text message.<sup>32</sup> In Brunet, the input messages are text messages from a keyboard, and then are converted into synthesized speech using TTS apparatus.<sup>33</sup> The office action has not explained why one skilled in the art would combine Brunet and Parvulescu such that an input text message would be converted to speech, then back into text, before being sent to a recipient. Brunet and Parvulescu thus teach away from the proposed combination.

The Office Action has also not identified a reasonable expectation of success in the prior art as is required by MPEP 2143. The office action has not shown how the elements of Brunet are to be added to the elements of Parvulescu.

The applicants respectfully submit that a *prima facie* case of obviousness has not been established against claims 2-3, and that claims 2-3 are in condition for allowance.

Claim 17 was rejected under 35 USC § 103(a) as being unpatentable over Parvulescu in view of Ogle. The applicants respectfully traverse.

Claim 17 is dependent on claim 14, and recites further features with respect to claim 14. The office action states that:

“It would have been obvious...that an IM server could drop a message if the receiving device were not connected for the reason that the server not get overloaded with undelivered messages.”<sup>34</sup>

The office action has not identified prior art as being the source of the above-quoted rationale for combining Parvulescu with Ogle as is required by MPEP 2143. The office action has also not identified a reasonable expectation of success in the prior art as is required by MPEP 2143.

The applicants respectfully submit that a *prima facie* case of obviousness has not been established against claim 17, and that claim 17 is in condition for allowance.

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<sup>32</sup> Parvulescu, Abstract.

<sup>33</sup> Brunet, Abstract.

<sup>34</sup> Office action, page 11.

**CONCLUSION**

The applicants respectfully submit that all of the pending claims are in condition for allowance, and such action is earnestly solicited. The Examiner is invited to telephone the below-signed attorney at 612-373-6973 to discuss any questions which may remain with respect to the present application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

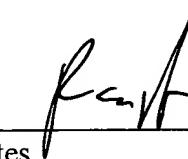
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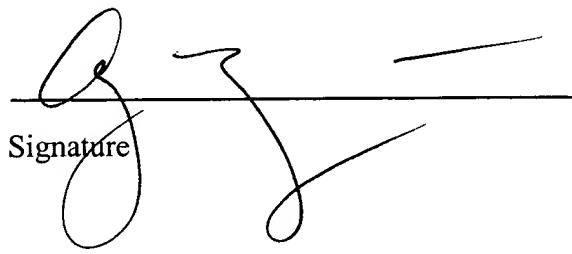
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